



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/642,891	08/21/2000	Jeffry Jovan Philyaw	RPXC-25,338	8887

25883 7590 02/05/2009
HOWISON & ARNOTT, L.L.P
P.O. BOX 741715
DALLAS, TX 75374-1715

EXAMINER

KANG, PAUL H

ART UNIT	PAPER NUMBER
----------	--------------

2444

NOTIFICATION DATE	DELIVERY MODE
-------------------	---------------

02/05/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patents@dalpat.com

Office Action Summary	Application No. 09/642,891	Applicant(s) PHILYAW, JEFFRY JOVAN	
	Examiner Paul H. Kang	Art Unit 2444	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 November 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on 26 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. In view of the Appeal Brief filed on April 22, 2008, PROSECUTION IS HEREBY REOPENED. A new grounds of rejection is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

/William C. Vaughn, Jr./

Supervisory Patent Examiner, Art Unit 2144.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

Art Unit: 2444

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-2 and 4-11 are rejected under 35 U.S.C. 102(e) as being anticipated by Horowitz et al., US Pat. App. Pub. No. US 2001/0013542 A1.

4. As to claim 1, Horowitz teaches the invention substantially as claimed. Horowitz teaches a system and method of accessing personal account information of a credit card associated with a user over a global communication packet-switched network, comprising the steps of:

at a user location disposed on the network, resolving a machine-resolvable code (MRC) having coded information contained therein and disposed on the credit card of the user, the coded information having no personal information contained therein relating to the user or routing information over a network (¶¶ 0020-0021, 0024);

extracting coded information from the MRC, the coded information associated with routing information that is associated with both the personal account information of the user and a credit card company server having stored thereat personal account information of the user, which routing information, personal account information and credit card server information are not stored on the credit card (¶¶ 0020-0021, 0024, 0027, 0028, 0030);

in response to the steps of resolving and extracting, obtaining the routing information to the credit card server associated with the extracted coded information (¶¶ 0024, 0028);

connecting the user location to the credit card company server across the network over a determined route in accordance with the routing information (¶¶ 0024, 0028);

Art Unit: 2444

connecting the user location to the specific and unique credit card company server across the network over a determined route during the step of connecting (§§ 0024, 0028);

transmitting the extracted coded information (account information) to the specific and unique credit card company server over the determined route during the step of connecting (§§ 0024, 0028);

using the transmitted coded information (customer account information) at the specific and unique credit card company server to determine the personal account information associated with the personal account information associated with the extracted coded information (§§ 0024-0025); and

returning the determined personal account information from the specific and unique credit card company server to the user location (§§ 0024-0025); and

presenting the information to the user at the user location (§§ 0024-0025).

5. As to claims 2, 4-5, and 8, Horowitz teach the system wherein the MRC is an optical indicia, a barcode, wherein the optical indicia is used to extract the corresponding routing information and personal identification information, wherein a unique code is transmitted to a remote intermediate location, and returning a matched remote location information to the user (§§ 0011, 0020-0021, 0024-0025, 0028).

6. As to claim 6, Horowitz teaches a wireless scanner (Horowitz teaches a wireless PDA used to scan credit cards; §§ 0011, 0020-0021, 0024-0025, 0028).

Art Unit: 2444

7. As to claim 7, Horowitz teach the use of a computer display at the user location (ATM; ¶¶ 0025, 0028).

8. As to claims 9 and 11, Horowitz teach a method for accessing personal information from a remote location on a network, as applied to claim 1 above, comprising the steps of:

reading at a user location on the network a unique information access code disposed on a portable access device that is carried by a user, which unique information access code is associated with routing information on the network to the remote location and also with personal information at the remote location of a user that is associated with the portable access device, wherein the association of the remote location with the unique information access code is unique to such unique information access code such that only that single remote location contains the associated personal information, wherein the routing information and personal information are not disposed on or in close proximity to the credit card (¶¶ 0020-0021, 0024, 0027, 0028, 0030);

obtaining the routing information from a database by comparing the unique information access code in a matching operation to a record in the database to determine if there exists in the record a pre-association between the unique information access code and at least one routing information and, if so, then allowing access to such matching routing information and accessing the remote location in accordance with the routing information (transaction data is transferred over the financial network and to the host system of the financial institution identified by the bank routing number, e.g. the network routing is inherently discovered by correlating the routing number to the network address of the server; ¶¶ 0020-0021, 0024, 0028);

Art Unit: 2444

transmitting to the remote location the unique information access code (¶¶ 0020-0021, 0024, 0028); and

at the remote location, receiving the unique information access code and accessing personal information associated therewith and forwarding the personal information back to the user location for viewing by the user (¶¶ 0005-0006, 0024-0025), the step of forwarding comprising:

sending from the remote location a request for personal identification after determining that there is contained in the database local to the remote location personal information associated with the unique information access code (¶¶ 0005-0006).

entering the personal identification information at the user location (¶¶ 0005, 0025); and

in response to input of a personal identification information by the user, returning the personal information to the user location (¶¶ 0005, 0025).

9. As to claim 10, Horowitz teach the method wherein the network is a global communication network (¶¶ 0025, 0011).

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 2444

11. Claims 3 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Horowitz et al. as applied, in view of Perkowski, US Pat. No. 6,064,979.

12. As to claim 3, Horowitz teaches the invention substantially as claimed. However, Horowitz fails to teach the method wherein the optical indicia is a bar code. In the art, Perkowski teaches using bar codes to easily input coded information. It would have been obvious to one having ordinary skill in the art to have applied the known technique of using input devices, such as bar code scanners, into the ATM systems of Horowitz for the predictable result of enabling another type of input device.

13. As to claim 12, Horowitz teaches the invention substantially as claimed. However, Horowitz fails to teach an intermediate location as claimed. Perkowski teaches the method wherein the step of accessing comprises the steps of:

in response to the step of reading, accessing an intermediate location on the network remote from the user location (Perkowski, col. 3, line 63 – col. 4, line 4; col. 5, lines 19-26 and col. 19, lines 12-55);

transmitting the unique information access code to the intermediate location from the user location (Perkowski, col. 3, line 63 – col. 4, line 4; col. 5, lines 19-26 and col. 19, lines 12-55);

the intermediate having contained thereat a database with associations between a plurality of unique information access codes and remote locations on the network (Perkowski, col. 3, line 63 – col. 4, line 4; col. 5, lines 19-26 and col. 19, lines 12-55);

Art Unit: 2444

comparing the received unique personal access code with the stored personal access code (Perkowski, col. 3, line 63 – col. 4, line 4; col. 5, lines 19-26 and col. 19, lines 12-55);

if a match is found, returning the matched remote location information to the user location (Perkowski, col. 3, line 63 – col. 4, line 4; col. 5, lines 19-26 and col. 19, lines 12-55);
and

utilizing the returned remote location information from the intermediate location to access the remote location (Perkowski, col. 3, line 63 – col. 4, line 4; col. 5, lines 19-26 and col. 19, lines 12-55).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have incorporated the known intermediate device of Perkowski into the ATM system of Horowitz to improve it's system, for the predictable result of applying known techniques of distributed data computing to the ATM system. The distributed nature allows enhancements in flexibility, security, scalability and redundancy of the networked system.

Claim Rejections - 35 USC § 103

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. **Claims 1-5 and 7-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Borecki et al., US Pat. App. No. US 2002/0016749 A1, in view of Perkowski., US Pat. No.**

Art Unit: 2444

6,064,979.

16. As to claim 1, Borecki teaches the invention substantially as claimed. Borecki teaches a system and method of accessing personal account information of a credit card associated with a user over a global communication packet-switched network, comprising the steps of:

connecting a user location to the specific and unique credit card company server across the network in accordance with a known URL (Borecki, Figure 2A and page 2, paragraph 0034-0035);

transmitting the account information to the specific and unique credit card company server over the network (Borecki, Figure 2A and page 2, paragraph 0034-0035 and page 3, paragraph 0039);

using customer account information at the specific and unique credit card company server to determine the personal account information associated with the customer account information from the credit card company server, to the user location (Borecki, page 3, paragraph 0040); and

presenting the information to the user at the user location (Borecki, page 2, paragraph 0034-0035 and page 3, paragraph 0040).

However, Borecki does not explicitly teach automating the steps of accessing said credit card company server. Specifically, Borecki does not explicitly teach:

at a user location disposed on the network, resolving a machine-resolvable code (MRC) having coded information contained therein and disposed on the credit card of the user, the coded information having no personal information contained therein relating to the user or routing information over a network;

Art Unit: 2444

extracting coded information from the MRC, the coded information associated with routing information that is associated with both the personal account information of the user and a credit card company server;

in response to the steps of resolving and extracting, obtaining the routing information to the credit card server associated with the extracted coded information;

connecting the user location to the credit card company server across the network over a determined route in accordance with the routing information.

In the a, Perkowski teaches a system and method for automatically retrieving information related to a commercial product by scanning an MRC, the coded information having no personal information contained therein relating to the user or routing information over a network (Perkowski, col. 3, line 63 – col. 4, line 4; col. 5, lines 19-26 and col. 19, lines 38-40).

Perkowski teaches at a user location disposed on the network, reading a machine-resolvable code (MRC) disposed on a commercial product of a user with a reading device (Perkowski, col. 3, line 63 – col. 4, line 4; col. 5, lines 19-26 and col. 19, lines 38-40);

extracting coded information from the MRC, the coded information associated with routing information that corresponds to the commercial product information stored on a company server disposed on the network (Perkowski, col. 19, lines 12-55);

in response to the steps of reading and extracting, obtaining the routing information associated with the extracted coded information (Perkowski, col. 19, lines 12-55);

connecting the user location to the company server across the network over a determined route in accordance with the routing information (Perkowski, col. 19, lines 12-55).

Art Unit: 2444

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have incorporated the known the automated data entry and data locating system of Perkowski into the system of Borecki to improve it's system for the predictable result of applying known techniques of automated data entry and distributed data computing to the system. The distributed nature allows enhancements in flexibility, security, scalability and redundancy of the networked system.

17. As to claims 2-5, and 8, Borecki-Perkowski teach the system wherein the MRC is an optical indicia, a barcode, wherein the optical indicia is used to extract the corresponding routing information and personal identification information, wherein a unique code is transmitted to a remote intermediate location, and returning a matched remote location information to the user (Borecki, Figure 2A and page 2, paragraph 0034-0035 and Perkowski, col. 3, line 63 – col. 4, line 4; col. 5, lines 19-26; and col. 19, lines 12-55).

18. As to claim 7, Borecki-Perkowski teach the use of a computer display at the user location (Borecki, page 2, paragraph 0034-0035 and page 3, paragraph 0040).

19. As to claims 9 and 11, Borecki-Perkowski teach a method for accessing personal information from a remote location on a network, as applied to claim 1 above, comprising the steps of:

reading at a user location on the network a unique information access code disposed on a portable access device that is carried by a user, which unique information access code is

Art Unit: 2444

associated with routing information on the network to the remote location and also with personal information at the remote location of a user that is associated with the portable access device (Perkowski, col. 3, line 63 – col. 4, line 4; col. 5, lines 19-26 and col. 19, lines 12-55);

accessing the remote location in accordance with the routing information (Perkowski, col. 19, lines 12-55);

transmitting to the remote location the unique information access code (Borecki, Figure 2A and page 2, paragraph 0034-0035 and page 3, paragraph 0039); and

at the remote location, receiving the unique information access code and accessing personal information associated therewith and forwarding the personal information back to the user location for viewing by the user (Borecki, Figure 2A and page 2, paragraph 0034-0035 and page 3, paragraph 0039);, the step of forwarding comprising:

sending from the remote location a request for personal identification after determining that there is contained in the database local to the remote location personal information associated with the unique information access code (Borecki, paragraphs 0034-0035),

entering the personal identification information at the user location (Borecki, paragraphs 0034-0035 and 0039-0040); and

in response to input of a personal identification information by the user, returning the personal information to the user location (Borecki, paragraphs 0039-0040).

20. As to claim 10, Borecki-Perkowski teach the method wherein the network is a global communication network (Borecki, page 2, paragraph 0031).

Art Unit: 2444

21. As to claim 12, Borecki-Perkowski teach the method wherein the step of accessing comprises the steps of:

in response to the step of reading, accessing an intermediate location on the network remote from the user location (Perkowski, col. 3, line 63 – col. 4, line 4; col. 5, lines 19-26 and col. 19, lines 12-55);

transmitting the unique information access code to the intermediate location from the user location (Perkowski, col. 3, line 63 – col. 4, line 4; col. 5, lines 19-26 and col. 19, lines 12-55);

the intermediate having contained thereat a database with associations between a plurality of unique information access codes and remote locations on the network (Perkowski, col. 3, line 63 – col. 4, line 4; col. 5, lines 19-26 and col. 19, lines 12-55);

comparing the received unique personal access code with the stored personal access code (Perkowski, col. 3, line 63 – col. 4, line 4; col. 5, lines 19-26 and col. 19, lines 12-55);

if a match is found, returning the matched remote location information to the user location (Perkowski, col. 3, line 63 – col. 4, line 4; col. 5, lines 19-26 and col. 19, lines 12-55);
and

utilizing the returned remote location information from the intermediate location to access the remote location (Perkowski, col. 3, line 63 – col. 4, line 4; col. 5, lines 19-26 and col. 19, lines 12-55).

22. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Borecki-Perkowski, as applied above, further in view of Brook et al., US Pat. No. 6,170, 746 B1.

Art Unit: 2444

23. As to claim 6, Borecki-Perkowski teach the invention substantially as claimed. However, Borecki-Perkowski does not explicitly teach a wireless scanner. In the same field of endeavor, Brook teaches a wireless barcode scanner (Brook, figure 1 and col. 3, line 6 – col. 4, line 41). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have incorporated the known wireless barcode scanner, as taught by Brook, to improve the system of Borecki-Perkowski, for the predictable result of increasing user convenience and mobility.

Response to Arguments

24. Applicant's arguments filed November 11, 2008 have been fully considered but they are not persuasive. Applicants argued in substance that:

- a. the claimed invention as amended to recite "that the credit card does not include personal account information, routing information or even information regarding the credit card server. All it contains is the unique access code or transaction code. *Horowitz* reference at the portion cited by the Examiner in paragraphs [0020]-[0021], [0024] and [0028] all refer to a credit card that has stored thereon a "special transaction number" ([0020]), which is associated with such things as a routing number to the bank, the bin number, and also an account number associated with the card. The magnetic stripe memory is utilized to store the customer name, account number and bank routing number information. Thus, the credit card has substantially everything that is necessary to identify that individual disposed thereon and, therefore, does not operate in accordance

Art Unit: 2444

with the claim system.” Remarks, page 7, lines 11-20

In response to point a, the examiner respectfully disagrees. As stated by the applicant, Horowitz teaches using a special transaction number to represent the transaction and the user. The purpose of using this number is to enhance security in banking transactions. Specifically, Horowitz teaches that "the application provides for the encoding and conversion of the transaction data into the special transaction number" which is associated with a mirror/phantom account, and further "the data necessary to effect a funds transfer is encrypted...and produces a cryptogram in the form of the special transaction number." See paragraphs 0027, 0028 and 0030. It is clear from the disclosure that the special transaction number is a representation of the transaction and does not list the personal account information nor credit card server information. Furthermore, claim recites "routing information over a network." On the contrary, the routing information disclosed by Horowitz and referred to by the applicant is the bank routing number used to identify a bank.

b. Applicants argue "after 'all' this information is provided, then the transaction is sent to a hold system." Remarks, page 7, lines 20-26.

As to point b, it is unclear what applicant refers to as being the "hold system." The limitation "hold system" is not disclosed in the prior art reference.

It is noted that applicants have not presented arguments with respect to the Borecki reference.

Conclusion

25. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul H. Kang whose telephone number is (571) 272-3882. The examiner can normally be reached on IFP.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Vaughn can be reached on (571) 272-3922. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2444

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Paul H Kang/
Primary Examiner
Art Unit 2444